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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

001062

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Application Number

09/643,912

Filed

8/23/00

First Named Inventor

ASAMI ET AL.

Art Unit

3748

Examiner

Tu Minh Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 56,527

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Ryan B. Chirnomas

Typed or printed name

202-822-1100

Telephone number

September 12, 2005

Date

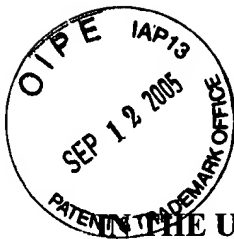
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **ASAMI et al.**

Group Art Unit: **3748**

Serial Number: **09/643,912**

Examiner: **Tu Minh Nguyen**

Filed: **August 23, 2000**

Confirmation Number: **9494**

For: **CATALYST WARMING CONTROL APPARATUS**

Attorney Docket Number: **001062**

Customer Number: **38834**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Date: September 12, 2005

REMARKS

Claims 5 and 8 are pending in the above-identified application. Claims 5 and 8, which form the basis for this Pre-Appeal Brief Request for Review, stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over **Kojima** (U.S. Patent No.6,253,866) in view of **Tsukamoto et al.** (U.S. Patent No. 5,771,478). The Office Action was made final, despite the fact that the rejection was based on newly-cited art and that no claim amendments were made in the preceding two responses. It is the position of the Office Action that **Kojima** discloses the invention as claimed except for the disclosure of a clutch. **Tsukamoto** is relied upon to provide the teaching which **Kojima** lacks.

The issue presented for review is whether or not **Tsukamoto** discloses a clutch as required by claim 5. Claim 5 specifically requires:

a clutch for performing the connection or disconnection of the transmission of power between the generator connected to the engine, and the motor.

This clutch for performing the “connection or disconnection of the transmission of power” is required in order to establish a *prima facie* rejection.

For at least the following reasons, the position of the Office Action, that **Tsukamoto** discloses a clutch for performing the connection or disconnection of the transmission of power between the generator connected to the engine and the motor, is a clear error of fact, and not a question of interpretation of the claims or prior art teachings. Therefore, the rejection of claims 5 and 8 should be withdrawn.

It is the position of the Office Action dated April 15, 2005 and the Advisory Action dated August 3, 2005 that **Tsukamoto** teaches “a clutch for performing *connection or disconnection* of the transmission of power between the generator connected to the engine and the motor.”

The Advisory Action acknowledges that **Tsukamoto** discloses a planetary gear box 16 linking the engine 11 to the motor/generator M1. It is correctly noted that the vehicle drive system is arranged such that ring gear R of planetary gear set 16 is connected to rotor 51 of the generator/motor M1, and the sun gear S is connected to engine output shaft 12 of internal combustion engine 11. It is also correctly noted that a clutch CL is present in the planetary gear set 16. Please see column 10, lines 42-51 and Figure 3.

However, the clear error lies in the suggestion that the clutch CL of **Tsukamoto** is “for performing the connection or disconnection of the transmission of power between the generator connected to the engine, and the motor.” In fact, the clutch CL of **Tsukamoto** actually discloses a clutch of a different type. This clutch *never disconnects* the transmission of power between the generator connected to the internal combustion engine 11 and the generator/motor M1.

In its preferred application, **Tsukamoto** discloses the use of a clutch as a coupling device in which the ring gear R and sun gear S are “locked together.” Alternatively, **Tsukamoto** discloses the locking of the ring gear R and carrier C together or the locking of carrier C and sun gear S together. Please see column 10, lines 52-60. When the clutch is engaged, any two of these gear elements (R and S; R and C; or C and S) are locked together and thus rotate together. When the clutch is disengaged, the gears are unlocked and the system works as a conventional planetary gear set, whereby the gears move at different speeds. In other words, regardless of whether or not the coupling clutch CL is engaged, there is *always* a transmission of power between the generator connected to internal combustion engine 11 and the motor/generator M1 of **Tsukamoto**. Thus, there is never a *disconnection* of power between the generator connected to internal combustion engine 11 and the generator/motor M1, only a difference in the force multiplication or division of the permanent connection.

In summary, Applicants respectfully submit that the clear error is the suggestion that **Tsukamoto** discloses “a clutch for performing the connection or disconnection of the transmission of power between the generator connected to the engine, and the motor,” as required by claim 5. Instead, **Tsukamoto** actually discloses a clutch which never performs a

Pre-Appeal Brief Request for Review
Serial No. 09/643,912
Attorney Docket No. 001062

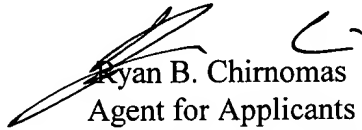
disconnection of power between internal combustion engine 11 and generator/motor M1.

Because a *prima facie* rejection requires all elements of the claims to be present, it is submitted that the rejection over **Kojima** in view of **Tsukamoto** does not present a *prima facie* case for rejecting claims 5 and 8.

In view of the remarks set forth above, Applicants submit that the rejection is improper. Accordingly, it is respectfully requested that the rejection of the claims be withdrawn and that present claims 5 and 8 be passed on to allowance.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Ryan B. Chirnomas
Agent for Applicants
Registration No. 56,527
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

RBC/meu